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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/354,726 12/06/94 SOUDA

S 42327

EXAMINER
FAN, J

12M1/1107

ART UNIT PAPER NUMBER

NIXON & VANDERHYE
1100 NORTH GLEBE ROAD
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1203

DATE MAILED: 11/07/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 11/2/95 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

- ☒ Claims 18-19 are pending in the application.
Of the above, claims are withdrawn from consideration.
- ☐ Claims have been cancelled.
- ☐ Claims are allowed.
- ☒ Claims 18-19 are rejected.
- ☐ Claims are objected to.
- ☐ Claims are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ; filed on
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

Art Unit: 1203

Claims 18-19 are again rejected under 35 USC 103 as being unpatentable over EP 074,341 alone or in view of EP 198,208 for reasons of record. Applicants' remarks and the data in the remarks have been carefully considered, but are deemed unpersuasive for the following reasons:

1. The rationale of In re Magerlein does not apply herein since the claimed compound (the intermediate) has other uses besides to be used to make the final product.

2. The data does not have any probative value since it is not in declaration form. Furthermore, the compounds compared are not the closest compounds. Moreover, the unexpected advantage (antibiotic use) is not disclosed in the specification. See In re Davies, 177 USPQ 381.

Claims 18-19 are again rejected under 35 USC 103 as being unpatentable over GB 2,134,523 or pat' 905 optionally in view of EP 198,208 for reasons of record. Also note the above rationale.

Claims 18-19 are again rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5,045,552 in view of GB 2,134,523 for reasons of record. Also note the above rationale.

Claims 18-19 are again provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claim of

Serial Number: 08/354,726

-3-

Art Unit: 1203

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copending application Serial No. 07/699,442 for reasons of record.

Claims 18-19 are again provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim of copending application Serial No. 07/699,442 for reasons of record.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE FAN whose telephone number is (703) 308-4705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JTF NOVEMBER 2, 1995


JANE FAN
PRIMARY EXAMINER
GROUP 1200